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In the Supreme Court of the United States

OCTOBER TERM, 1942

No. 799

THE PHILADELPHIA INQUIRER COMPANY,
PETITIONER

v.

CONWAY P. COE, COMMISSIONER OF PATENTS

*ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED
STATES COURT OF APPEALS FOR THE DISTRICT OF
COLUMBIA*

BRIEF FOR THE RESPONDENT IN OPPOSITION

OPINIONS BELOW

The opinion of the District Court (R. 26-34) dismissing petitioner's complaint is reported in 38 F. Supp. 427. The opinion of the United States Court of Appeals for the District of Columbia (R. 55-65) is not yet reported.

JURISDICTION .

The judgment of the United States Court of Appeals for the District of Columbia was entered December 8, 1942 (R. 66). The petition for a writ of certiorari was filed March 8, 1943. The

jurisdiction of this Court is invoked under Section 240 (a) of the Judicial Code, as amended by the Act of February 13, 1925.

QUESTION PRESENTED

Whether, in the circumstances of this case, the Commissioner of Patents improperly refused to issue a certificate of registration for the trade-mark "EVERYBODY'S WEEKLY", used by petitioner as the title of the weekly magazine supplement contained in its Sunday newspaper edition, on the ground that an identical mark had concededly been in prior use by a British weekly magazine circulated in the United States.

STATUTE INVOLVED

Section 5 of the Trade Mark Act of 1905 (Act of February 20, 1905, c. 592, 33 Stat. 724; 15 U. S. C. § 85) provides in part:

no mark by which the goods of the owner of the mark may be distinguished from other goods of the same class shall be refused registration as a trade-mark on account of the nature of such mark * * *

(b) * * * *Provided*, That trade-marks which are identical with a registered or known trade-mark owned and in use by another, and appropriated to merchandise of the same descriptive properties, or which so nearly resemble a registered or known trade-mark owned and in use by another, and appropriated to merchandise of the same descriptive properties, as to be likely

to cause confusion or mistake in the mind of the public, or to deceive purchasers, shall not be registered: * * *

STATEMENT

On May 22, 1937, petitioner filed an application in the United States Patent Office for the registration of the trade-mark "EVERYBODY'S WEEKLY" for a weekly newspaper section (R. 7). An opposition filed by King Features Syndicate, Inc., based upon its use of the mark or name "EVERYBODY'S PICTORIAL WEEKLY" (R. 12, 27), was dismissed by the Examiner of Interferences because the opposer failed to show that it had used that mark before petitioner's earliest use of its own mark (R. 12), and no appeal was taken from this decision (R. 15). However, during the hearing on the opposition before the Examiner, the opposer had introduced a copy of a British magazine bearing the mark or title "EVERYBODY'S WEEKLY" (R. 13), which was published prior to petitioner's adoption of the name and which enjoyed some circulation in this country.¹ The Examiner of Interferences found that the British magazine and petitioner's publication possessed the same descriptive properties and that because of the close resem-

¹ The front page of the British publication contains the title "EVERYBODY'S—The popular Weekly," and the inside pages have the heading "EVERYBODY'S WEEKLY" (R. 13, 52, 53).

blance of the marks there was some likelihood of confusion; he therefore refused registration of petitioner's mark (R. 13). This decision was affirmed by the Assistant Commissioner of Patents, who held that while the likelihood of confusion was slight, denial of registration was proper because the two marks were "identical" and were "appropriated to merchandise of the same descriptive properties" within the meaning of Section 5 of the Trade Mark Act of 1905 (R. 16; rehearing denied R. 23, 24).

Petitioner thereupon brought this suit in the United States District Court for the District of Columbia, under Section 4915 of the Revised Statutes, as amended (35 U. S. C. § 63),² to direct the respondent, the Commissioner of Patents, to issue to petitioner a certificate of registration of its trade-mark, which the complaint alleged respondent had refused (R. 4). After a trial, the district court dismissed the complaint (R. 34), finding as facts that petitioner's mark was "iden-

² This section, authorizing proceedings in the Federal district courts to review a refusal by the United States Patent Office to issue a patent on application, has been held also to be applicable to refusal by the Patent Office of an application for trade-mark registration. *American Steel Foundries v. Robertson*, 262 U. S. 209; *Baldwin Co. v. Robertson*, 265 U. S. 168, 179-181; *Drackett Co. v. Chamberlain Co.*, 81 F. (2d) 866 (C. C. A. 3), certiorari denied, 299 U. S. 503; *Hygienic Products Co. v. Coe*, 85 F. (2d) 264, 266 (App. D. C.); *Tomlinson of High Point v. Coe*, 123 F. (2d) 65 (App. D. C.).

tical with the mark in prior use by the British magazine" and that the two publications in question were "merchandise of the same descriptive properties" under Section 5 of the Act (R. 25). The trial court held that the likelihood of confusion is not material where the marks are identical and are applied to merchandise of the same descriptive properties, and that whether the descriptive properties are the same is not necessarily controlled by the likelihood of confusion between the publications (R. 26-34). The court below affirmed the judgment of the district court (R. 55-60), one Justice dissenting (R. 60-65). The opinion of the majority agreed with the reasoning of the trial court, also holding that if it is patently clear that the goods possess the same descriptive properties, extrinsic evidence as to the likelihood of confusion is not necessarily determinative (R. 55-60).

ARGUMENT

The proviso of Section 5 (b) of the Trade Mark Act of 1905 (*supra*, pp. 2-3) clearly specifies two classes of cases in which registration is to be denied on account of "a registered or known trade-mark" owned and in use by another and appropriated to "*merchandise of the same descriptive properties*":³ (1) where the two trade-marks are

³ The italicized phrase is generally interpreted as synonymous with "goods of the same class" as the latter term is used in the initial sentence of Section 5 (*supra*, p. 2). *Cheek-Neal Coffee Co. v. Hal Dick Mfg. Co.*, 40 F. (2d)

“identical,” and (2) where the applicant’s trade-mark “so nearly resembles” the other “as to be likely to cause confusion or mistake in the mind of the public or to deceive purchasers.”

Petitioner accepts this analysis (Pet. 5, 8) and concedes the identical nature of its mark and the British mark as well as the antecedent use of the British mark (Pet. 6, 8). Petitioner’s contention is simply that in determining whether identical marks apply to merchandise of the same descriptive properties, the definitive test should be the likelihood of confusion (Pet. 8); and that the courts below erred in refusing to consider the opinion testimony of two trade witnesses that the concurrent use of the marks on the two publications would not cause confusion among prospective purchasers. Both these grounds are clearly without merit.

1. Petitioner’s theory, that the likelihood of confusion should be the sole test of whether the merchandise is of the same descriptive properties, would render most of the words of the proviso meaningless, and, as the court below pointed out, in effect would rewrite the statute (R. 57).⁴ For if merchandise is not of the same class unless

106, 107 (C. C. P. A.); *Cross v. Williams Oil-O-Matic Heating Corp.*, 48 F. (2) 659, 660 (C. C. P. A.); Nims, *Unfair Competition and Trade-Marks* (3d ed. 1936) § 229 (b), p. 621.

⁴See also concurring opinions in *California Packing Corp. v. Tillman & Bendel*, 40 F. (2d) 108, 114 (C. C. P. A.), and *B. F. Goodrich Co. v. Hockmeyer*, 40 F. (2d) 99, 104 (C. C. P. A.).

likely to be confused when bearing similar marks, then the entire first clause relating to identical marks becomes surplusage, and the second clause concerning similar marks becomes partly tautological. The court below properly observed that petitioner's contention would have the proviso read simply that no mark shall be denied registration unless likely to cause confusion (R. 57). No case has upheld that construction,⁵ and aside from the decision below, there is authority to indicate the contrary. Cf. *Rosenberg v. Elliott*, 7 F. (2d) 962 (C. C. A. 3); *Cheek-Neal Coffee Co. v. Hal Dick Mfg. Co.*, 40 F. (2d) 106 (C. C. P. A.).

2. The trial court held that whether the publications were merchandise of the same descriptive properties is a question of fact, to be determined "on the whole of the relevant evidence," and that while the opinion testimony of petitioner's witnesses as to likelihood of confusion is pertinent to that issue, it alone would not justify disregarding the obvious fact that the merchandise itself is of the same class.⁶ The trial court made findings

⁵ *Dicta* of the Court of Customs and Patent Appeals, which might lend support to that view, occur in cases involving products dissimilar on their faces, e. g., coffee v. fruits, shoes v. clothing (*California Packing Corp. v. Tillman & Bendel*, 40 F. (2d) 108; *B. F. Goodrich Co. v. Hockmeyer*, 40 F. (2d) 99). Doubt is cast upon such *dicta* by the same court's remarks in the more recent case of *Meredith Publishing Co. v. O. M. Scott & Sons Co.*, 88 F. (2d) 324, 326, 328.

⁶ "If the merchandise of itself is obviously of the same class, that fact cannot properly be disregarded merely be-

of fact that petitioner's magazine section and the British magazine in question were publications printed in English, having quite similar contents, and that the merchandise in question was of the "same descriptive properties" (R. 25). These findings, which were affirmed by the court below⁷ are in accord with those made in the Patent Office,⁸

cause individual opinion testimony of witnesses tends to show the likelihood of confusion is non-existent. But of course where there is doubt whether the merchandise, intrinsically considered, is of the same class, resort may very properly be had to extrinsic evidence as to confusion, which may in any such given case be of controlling importance in view of the undoubted consideration that the primary purpose of the whole trade-mark law, as a part of the wider subject of unfair competition, is to prevent confusion of the public as to the origin of goods of competing vendors. *American Steel Foundries v. Robertson*, 269 U. S. 372, 380; 63 C. J. Trade-Marks, p. 474, s. 147; *Affiliated Products Inc. v. Crazy Water Co.* (C. C. P. A.) 104 F. (2d) 366, 367" (R. 31).

⁷ "In the present case it has been clear to the Examiner, to the Assistant Commissioner, to the District Court, and now to us, that a magazine supplement section of a Sunday newspaper belongs to the same class for the purpose of trade-mark registration as a stapled, tabloid, weekly news-magazine. Just as extrinsic evidence would be cumulative when it was already clear that goods were not related, so here when the goods are so closely related, any amount of testimony that there was no 'confusion' (of the source) in fact would not alter the conclusion that the goods are of the same descriptive properties" (R. 59).

⁸ In the Patent Office proceedings, the Examiner of Interferences (R. 12-13) and the Assistant Commissioner of Patents (R. 15-16, 23-24) also found that the merchandise was of the same descriptive properties, the latter adding that it could not seriously be argued otherwise (R. 16, 24).

upon which rests "the power and the duty" to determine the question of similarity "in each case in the exercise of an instructed judgment upon a consideration of all the pertinent facts." *American Steel Foundries v. Robertson*, 269 U. S. 372, 382.

Petitioner has failed to sustain its burden of showing by clear and convincing evidence that the decision of the Commissioner of Patents denying registration was erroneous. *Century Distilling Co. v. Continental Distilling Co.*, 106 F. (2d) 486 (C. C. A. 3), certiorari denied, 309 U. S. 662. And since the findings of the district court are supported by the evidence, their affirmance below was proper. Cf. *Sharp v. Coe*, 125 F. (2d) 185, 189 (App. D. C.) (patent registration).

The decision below that a weekly magazine supplement section of a newspaper and a weekly tabloid news-magazine are merchandise of the same descriptive properties finds support on an *a fortiori* basis in similar decisions by the Court of Customs and Patent Appeals regarding bacon and coffee (*Forst Packing Co., Inc. v. C. W. Antrim & Sons*, 118 F. (2d) 576), canned fish and tea (*Tetley & Co., Inc. v. Bay State Fishing Co.*, 82 F. (2d) 299), and sugar and canned meat (*Revere Sugar Refinery v. Salvato*, 48 F. (2d) 400).

3. The asserted conflict in decisions (Pet. 9-12) is unreal. The case most strongly urged by peti-

tioner as conflicting with the decision below is *Yale Electric Corp. v. Robertson*, 26 F. (2d) 972 (C. C. A. 2), in which the court, apparently assuming that the trade-marks were identical, considered whether flashlights and locks were "merchandise of the same descriptive properties." In the first sentence of a paragraph, the entire remainder of which petitioner sets forth (Pet. 9, 10), the court said:

There remains the question of registration, the goods not being of the "same descriptive properties" in the colloquial sense.

Thus the case was one where the articles were not of the same class, were not apparently similar, and therefore extrinsic evidence of confusion had to be considered, in view of the purpose of the trade-mark law to prevent confusion of the public as to the origin of goods. Both courts in the instant case recognized the propriety of considering extrinsic evidence in such circumstances. The trial court in the instant case conceded that evidence as to likelihood of confusion may "be of controlling importance" in such circumstances (R. 31), and the opinion below contains similar language (R. 59).⁹

⁹ The other cases relied on by petitioner to establish a conflict are similarly distinguishable, and are distinguishable for the further reason that in none were the trade-marks held to have been "identical". *Ph. Schneider Brewing Co. v. Century Distilling Co.*, 107 F. (2d) 699 (C. C. A. 10)

CONCLUSION

The decision of the court below is correct. No conflict exists with regard to the issue presented in the instant case and the question is not one of general importance. It is respectfully submitted that the petition for writ of certiorari should be denied.

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APRIL 1943.

(hard liquors as opposed to beer; different marks containing only one common word); *California Packing Corp. v. Price-Booker Mfg. Co.*, 285 Fed. 993 (App. D. C.) (pickles and relishes as opposed to canned fruits and vegetables; marks "substantially the same"); *B. F. Goodrich Co. v. Hockmeyer*, 40 F. (2d) 99 (C. C. P. A.) (overshoes as opposed to clothing; marks "confusingly similar"). Remarks in the last cited case and in *California Packing Corp. v. Tillman & Bendel*, 40 F. (2d) 108, (C. C. P. A.) (tinned coffee as opposed to canned fruits and vegetables), to the effect that the likelihood of confusion is the test of similarity of class, are only *dicta*, for the cases involved apparently different products, requiring resort to extrinsic evidence in order to determine whether registration should be granted.